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EXAMINER

DIXON, THOMAS A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 08/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/904,707

Applicant(s)

MAGGIONCALDA ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-13 is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ 2d 1077 (Fed. Cir. 1994).

2. This application repeats a substantial portion of prior Application No. 09/495,982, filed 01 January 2000, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It was not executed in accordance with either 37 CFR 1.66 or 1.68.

### ***Specification***

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4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, line 4 of claim 14 contains the phrase "and/or" which makes the claim indefinite.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-7, 9-10, 14-24, 26-28, 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Edesess (5,884,287).

As per Claim 1.

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Edesess ('287) discloses:

displaying a set of one or more input objects, the input objects to receive one or more input decisions including an indication of a target retirement age, an indication of a target level of investment risk and an indication of retirement income goal, see figure 4 (target \$1,750,000 at age 65) and column 4, lines 45-55;

displaying a set of one or more output values, the set of output values including an indication of the probability of achieving the retirement income goal and an indication of the most likely retirement income in current dollars based upon one or more input decisions and a recommended set of financial products, see figure 4 (Likelihood (%));

receiving an updated input decision via one or more of the input objects, see column 4, line 61 – column 5, line 4;

determining one or more new output values to reflect the one or more new output values, see column 5, line 23 – column 6, line 32;

refreshing the set of one or more output values to reflect the one or more new output values, see column 6, lines 28-65.

As per Claim 2.

Edesess ('287) further discloses one or more objects are displayed concurrently on the same screen, see figure 4 (target \$1,750,000 at age 65).

As per Claim 3.

Edesess ('287) further discloses the target retirement is constrained to be feasible, see column 5, lines 1-4 and figure 3A (106).

As per Claim 4.

Edesess ('287) further discloses displaying the recommended set of financial products, the recommended set of financial products conditional on the one or more input decisions, see column 2, lines 35-40.

As per Claim 5.

Edesess ('287) further discloses displaying a recommended allocation of wealth among those of the financial products in the recommended set of financial products, see column 2, lines 35-40.

As per Claim 6.

Edesess ('287) further discloses the recommended allocation of wealth is conveyed graphically, see figure 4 (Recommended Asset Allocation).

As per Claim 7.

Edesess ('287) discloses:

a) receiving a retirement income goal from the user, see column 4, lines 45-55;

b) receiving one or more input decisions from the user, including an indication of a target retirement age and an indication of a target level of investment

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risk, upon which a probability distribution is dependent, the probability distribution representing a set of possible future portfolio values based upon the one or more input decisions, see column 2, lines 18-22, column 4, lines 45-55 and figure 4 (target \$1,750,000 at age 65);

c) determining a probability of achieving the retirement income goal, see column 4, lines 56-60; and

d) displaying the probability of achieving the retirement income goal to the user, see figure 4 (Likelihood(%)).

As per Claim 9.

Edesess ('287) further discloses displaying the recommended set of financial products and a recommended allocation of wealth among the financial products in the set of recommended financial products, see column 2, lines 35-40.

As per Claim 10.

Edesess ('287) further discloses displaying the probability of achieving the income goal graphically, see figure 4 (Likelihood(%)).

As per Claim 14.

Edesess ('287) discloses:

receiving an indication of a retirement income goal from the user, see column 4, lines 38-60;

receiving one or more inputs including retirement age or other decision variables upon which a probability distribution is dependent, the probability distribution representing probabilities over time of the user achieving the retirement income goal, see column 4, lines 3—60 and figure 4 (target at age 65);

displaying an indication of risk of not achieving the financial goal based upon the probability distribution, see figure 4 (Likelihood(%)).

As per Claim 15.

Edesess ('287) further discloses the indication of risk of not achieving the retirement income goal comprises an icon, see figure 4 (Likelihood(%)).

As per Claim 16.

Edesess ('287) discloses:

determining a recommended allocation of wealth among one or more financial products of the set of available financial products based upon one or more decision inputs including an indication of a target level of investment risk, see column 6, line 33-65;

depicting the recommended allocation of wealth among the one or more financial products of the set of available financial products, see figure 4 (Recommended Asset Allocation).

As per Claim 17

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Edesess ('287) further discloses depicting the recommended allocation graphically, see figure 4 (Recommended Asset Allocation).

As per Claim 18.

Edesess ('287) discloses:

displaying one or more objects in a first portion of a first screen, the input objects configured to receive one or more input decisions including a financial goal, from which a recommendation is determined, the recommendation including a recommended allocation of wealth among a set of available financial products, see figure 4 and column 6, lines 28-65;

displaying a set of output values in a second portion of the first screen, the set of output including a probability of achieving the financial goal based upon the recommendation, see figure 4, (Likelihood(%)); and

graphically depicting the recommended allocation of wealth among the set of available products in a second screen, see figure 4 (Recommended Asset Allocation) and column 6, lines 28-65.

As per Claim 19.

Edesess ('287) further discloses one or more input decisions include an indication of a target retirement age, see figure 4 (at age 65).

As per Claim 20.

Edesess ('287) discloses:

means for displaying a set of one or more input objects, the input objects to receive one or more input decisions including an indication of a target retirement age, an indication of a target level of investment risk, and an indication of a retirement income goal, see column 6, lines 28-65;

means for displaying a set of one or more output values, the set of output values including an indication of the probability of achieving the retirement income goal and an indication of the most likely retirement income in current dollars based upon one or more input decisions and a recommended set of financial products, see column 6, lines 28-65 and figure 4;

means for receiving an updated input decision via one or more of the input objects, see column 6, lines 28-32;

means for determining one or more new output values based upon the updated input decision, see column 6, lines 28-65; and

means for refreshing the set of one or more output values to reflect the one or more new output values, see column 6, lines 28-32.

As per claim 21.

Edesess ('287) further discloses a means for displaying the recommended set of financial products, the recommended set of financial products conditional on the one or more input decisions, see figure 4 (Recommended Asset Allocation).

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As per claim 22.

Edesess ('287) further discloses the recommended allocation of wealth is conveyed graphically, see figure 4.

As per Claim 23.

Edesess ('287) discloses:

- a step for displaying a set of one or more input objects, the input objects to receive one or more input objects to receive one or more input decisions including an indication of a target retirement age, an indication of a target level or risk and an indication of a retirement income goal, see column 6, lines 28-65;

- a step for displaying a set of one or more output values, the set of output values including an indication of the probability of achieving the retirement income goal and an indication of the most likely retirement income in current dollars based upon one or more input decisions and a recommended set of financial products, see column 6, lines 28-65 and figure 4;

- a step for receiving an updated input decision via one or more of the input objects, see column 6, lines 28-65;

- a step for determining one or more new output values based upon the updated input decision, see column 6, lines 28-65; and

- a step for refreshing the set of one or more output values to reflect one or more new output values, see column 6, lines 28-65.

As per Claim 24.

Edesess ('287) further discloses the target retirement age is constrained to be feasible, see column 5, lines 1-4 and figure 3A (106).

As per Claim 26.

Edesess ('287) discloses:

- means for displaying one or more input objects in a first portion of a first screen, the input objects configured to receive one or more input decisions including a financial goal, from which a recommendation is determined, the recommendation including a recommended allocation of wealth among a set of available financial products, see column 6, lines 28-65 and figure 4 (Recommended Asset Allocation);

- means for displaying a set of output values in a second portion of the first screen, the set of output values including a probability of achieving the financial goal based upon the recommendation, see figure 4 (Likelihood(%));

- means for graphically depicting the recommended allocation of wealth among the set of available financial products in a second screen, see figure 5.

As per Claim 27.

Edesess ('287) further discloses one or more input decisions include an indication of a target retirement age, see figure 4 (at age 65).

As per Claim 28.

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Edesess ('287) discloses:

a step for displaying one or more input objects in a first portion of a first screen, the input objects configured to receive one or more input decisions including a financial goal, from which a recommendation is determined the recommendation including a recommended allocation of wealth among a set of available financial products, see column 6, lines 28-65;

a step for displaying a set of output values in a second portion of the first screen, the set of output values including a probability of achieving a financial goal based upon the recommendation, see figure 4 (Likelihood(%));

a step for displaying for graphically depicting the recommended allocation of wealth among the set of available products in a second screen, see figure 5.

As per Claim 32.

Edesess ('287) discloses:

concurrently displaying

a set of one or more input objects, the input objects to receive one or more input decisions including an indication of a target retirement age, and an indication of a retirement income goal, see column 6, lines 28-65;

a set of one or more output values, the set of output values including the most likely value at retirement of a portfolio of available financial products previously input by the user, see column 6, lines 28-65;

receiving an updated input decision via one or more of the input objectives, see column 6, lines 28-32;

determining one or more new output values based upon the updated input decision, see column 6, lines 28-32;

refreshing the set of one or more output values to reflect the one or more new output values, see column 6, lines 28-32.

As per Claim 33.

Edesess ('287) further discloses the target retirement age is constrained to be feasible, see column 5, lines 1-4 and figure 3A (106).

### ***Claim Rejections - 35 USC § 103***

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8, 25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edesess (5,884,287).

As per Claim 8.

Edesess ('287) further discloses a graphical input mechanism, see column 4, lines 26-37 and risk as an input to the determination of the efficient frontier, see column 2, lines 18-22.

Edesess ('287) does not specifically teach one of the input objects includes a target level of investment risk.

This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed. Cir. 1983).

Therefore it would have been obvious to one of ordinary skill at the time the invention was made to include a target level of risk in the input objects as a design choice.

As per Claim 25.

Edesess ('287) further discloses a graphical input mechanism, see column 4, lines 26-37 and risk as an input to the determination of the efficient frontier, see column 2, lines 18-22.

Edesess ('287) does not specifically teach one of the input objects includes a target level of investment risk.

This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed. Cir. 1983).

Therefore it would have been obvious to one of ordinary skill at the time the invention was made to include a target level of risk in the input objects as a design choice.

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As per Claim 29.

Edesess ('287) further discloses risk as an input to the determination of the efficient frontier, see column 2, lines 18-22.

Edesess ('287) does not specifically teach one of the input objects includes a target level of investment risk.

This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed. Cir. 1983).

Therefore it would have been obvious to one of ordinary skill at the time the invention was made to include a target level of risk in the input objects as a design choice.

9. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edesess (5,884,287) in view of Baird et al (5,220,500).

As per Claim 30.

Edesess ('287) discloses:

a processor, see column 4, line 12;

a memory coupled with the processor to store a financial advisory system, see column 4, lines 5-20;

one or more input objects in a first portion of a first screen, the input objects configured to receive one or more input decisions including a financial goal, from which a recommendation is determined, the recommendation including a recommended allocation of wealth among a set of available financial products, see column 6, lines 28-65;

a set of output values in a second portion of the first screen, the set of output values including a probability of achieving a financial goal based upon a recommendation, see column 6, lines 28-65 and figure 4;

a graphical depiction of the recommended allocation of wealth among the set of available financial products in a second screen, see figure 5.

Edesess ('287) does not specifically disclose:

the processor to send information to a client machine to display on the client machine.

Baird et al ('500) teaches external data sent to a client machine, see figure 2 (13 to 11) for the benefit of increased access to data.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to send information to a client machine for display in the invention of Edesess ('287) as taught by Baird et al ('500) for the benefit of increased access to data.

As per Claim 31.

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Edesess ('287) further discloses one or more input objects includes an indication of a retirement income goal, see column 6, lines 33-65.

Edesess ('287) does not specifically teach one of the input objects includes a target level of investment risk.

This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed. Cir. 1983).

Therefore it would have been obvious to one of ordinary skill at the time the invention was made to include a target level of risk in the input objects as a design choice.

### ***Allowable Subject Matter***

10. Claims 11-13 are allowable.

As per Claim 11.

Edesess ('287) discloses:

concurrently displaying

input objects in a first portion of a screen, see column 2, lines 18-22, column 4, lines 38-60, figure 4;

a set of one or more output values in a second portion of the screen, see figure 4 and column 6, lines 28-65;

receiving an updated input decision via one of the depicted input objects, see column 4, line 61 – column 5, line 4 and column 6, lines 28-32;

determining one or more new output values based upon the updated values, column 6, lines 28-65; and

updating the second portion of the screen to reflect the one or more new output values, see column 6, lines 49-65.

Edesess ('287) does not specifically disclose:

the input objects configured to receive one or more input decisions including level of risk, and

a set of one or more output values in a second portion of the screen, the set of output value including the short-term risk associated with reaching a financial goal.

The claims which depend from the above allowable claim are allowable for the same reason.

### ***Prior Art Made of Record***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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PCT WO/96/0606502 to Knowles et al is the closest foreign art which discloses a portfolio performance analysis system but does not disclose all the limitations of the claims.

Asymmetric risk measures and tracking models for portfolio optimization under uncertainty is the closest non patent literature which discusses portfolio selection and risk, but does not disclose all the limitations of the claims.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Thomas A. Dixon  
Examiner  
Art Unit 3629

August 29, 2002